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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,866	09/20/2000	Brian J. Brown	S63.2-9397	1548

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EXAMINER

PREBILIC, PAUL B

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,866

Applicant(s)

BROWN ET AL.

Examiner

Paul B. Prebilic

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-21, 23, 24 and 26-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-21, 23, 24 and 26-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 26-35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to claims 20-21, 29, 30, and 31, the subject matter of these claims lacks original support wherein sections of the connectors were not originally disclosed or contemplated.

With regard to claim 26 and its dependent claims 27-33, on lines 33-35 of claim 26, the ratio of connector struts to expansion struts was not originally disclosed or contemplated, and thus, it is not seen how it has original support.

With regard to claims 26-35, the language "the first and second expansion struts joined at the distal (or proximal) end only" is not originally supported and it not understood because the first and second struts are joined in two places, once at each end. In fact, in order for the column to hold together, each first strut must be connected to two adjacent second struts, one at each end thereof; see Figure 2.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the language of the claims lacks clear antecedent basis from the specification such that it is not clear what structure or element of the specification corresponds to the structure or element of the claims. For example, it is not clear what corresponds to the "joining strut", "proximal section", "distal section", etc.

With regard to claims 26-35, the new language that allows only one attachment per strut renders the claimed structure indefinite and inoperable. At least, it is unclear what is being claimed; see the 35 USC 112, first paragraph rejection above.

With regard to claim 34, the meaning of "non-parallel" is not clear because oblique angles were disclosed in the specification. It is not clear whether these terms have the same scope; i.e. it is unclear what the scope of the claims is intended to be.

Claim Rejections Base Upon Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application

Art Unit: 3738

being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 16-21, 23, 24, and 26-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Schnepf-Pesch et al (US 5,860,999). Schnepf-Pesch et al anticipate the claim language wherein the struts (7, 7') thereof are angularly offset and the connectors (4) meet all the claim limitations; Figure 2 reads on the claimed invention even though it is partially expanded because it could clearly be expanded more; see the whole document, especially Figure 2 and the abstract. It is noted that which strut of Schnepf-Pesch calls the first and second strut can change from one strut column to the next such that the claim language is read on even when Figure 1 is utilized. Therefore, even the parallel and offset language reads on the claim language when Schnepf-Pesch is interpreted in this manner using claim 1 as the basis of the interpretation.

With regard to claims 16-21, 23, and 24, the Examiner notes the similarity to patented claims of Jang (US 5,954,743). However, in order to advance prosecution as far as before, and if, an interference is established, the Examiner decided to present this rejection.

Claim 34 is rejected under 35 U.S.C. 102(e) as being anticipated by Richter et al (US 6,156,052) wherein the connectors are shown as element (30) of Figure 2B; see the whole document and especially Figure 2A which has an offset connection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3738

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-33 are rejected under 35 U.S.C. 102(e) as anticipated by Richter et al (US 6,156,052) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Richter et al (US 6,156,052) in view of Schnepf-Pesch et al (US 5,860,999). Richter et al anticipates the claim language where the connector struts to expansion struts ratio is inherently within the claim range because the connector struts are intended to give axial flexibility to the stent; see Figure 2A for example.

Alternatively, one could interpret the claim language as not being met because there is no explicit disclosure of the struts ratio as claimed. Schnepf-Pesch et al, however, teach that it was known to make similar stents with a certain number of connectors in order to provide flexibility; see the abstract. Hence, it is the Examiner's position that it would have been obvious to adjust the connector properties or numbers in order to make the Richter et al more flexible so that it could be used in a curved part of the vasculature.

Claims 26-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Palmaz (US 5,102,417) wherein the ratio as claimed is met because the Palmaz device can be bent at the connector section; see the whole document. Due to the confusing new language to claims 26-34, the Examiner posits that Palmaz would read on the claims if interpreted in a manner which makes them operable and which precludes more than two end connections per strut.

Response to Arguments

Applicant's arguments filed May 20, 2002 have been fully considered but they were not persuasive or moot in view of new grounds of rejection.

Applicant argues that there is support for the various rejections maintained. However, upon review of the specification and Applicant's comments no such support could be found. For this reason, the rejections have been maintained. Merely looking at a drawing such as Figure 2 does not give the claimed features support of clear support.

Applicant argues that the terms used in the claims have clear antecedent support and are definite. However, the Examiner opines that one of ordinary skill would not find the claimed elements inherent to the specification due to the number of elements claimed and number of features disclosed.

With regard to the claim 34 and the indefiniteness due to "non-parallel", the Examiner is unclear what falls within the claim scope for such a term and whether oblique angled struts are considered non-parallel. Applicant has failed to address this concern in the response.

In the traversal of the Section 102 Schnepf-Pesch rejection, Applicant argues that a partially expanded state of Figure 2 cannot read on the non-expanded state as claimed. However, the Examiner asserts that the claims merely set forth a non-expanded state and so anything short of full expansion is a non-expanded state given its broadest reasonable interpretation. Furthermore, upon review of Figure 1, it is clear

Art Unit: 3738

that the first and second struts of adjacent strut columns are arbitrary such that it reads on the claimed invention also.

As to the other prior art rejections, the Examiner has addressed the arguments by adding further description of the rejection to explain how the reference is being applied.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned problem is corrected.

Art Unit: 3738

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic
Primary Examiner
Art Unit 3738